

REMARKS UNDER 37 CFR § 1.111

Formal Matters

Claims 1-22, 40-50 and 56-60 are pending after entry of the amendments set forth herein.

Claims 15, 16, 21 and 48 are currently withdrawn from consideration.

Claims 1-14, 17-20, 22, 40-47, 49-50 and 56-60 were examined. Claims 1-14, 17-20, 22, 40-47, 49-50 and 56-60 were rejected.

Applicant respectfully requests reconsideration of the application in view of the amendments and remarks made herein.

No new matter has been added.

The Office Action

Claims Rejected Under 35 U.S.C. Section 112, Second Paragraph

In the Official Action of October 10, 2007, claims 1-14, 17-20, 22, 40-47, 49-50 and 56-60 were rejected under 35 U.S.C. Section 112, second paragraph as being indefinite.

With regard to claims 1, 43 and 56, the Examiner asserted that the relationship between the preamble and the method steps (recitations in the bodies of the claims) were vague and indefinite, as the Examiner interpreted the claims as not including steps resulting in the intended use resulting in the preamble. In response thereto, Applicant has amended each of claims 1, 43 and 56 above so that the preamble recites displaying and manipulating data. It is respectfully submitted that the bodies of each of claims 1, 43 and 56 contain recitations that cover displaying and manipulating data.

The Examiner further asserted that claims 43-47 and 49-50 recited means plus function language and that the specification does not identify specific structure to correspond to the claims functions of each of the means plus function recitations in the claims. Without acquiescing to the Examiner's assertion, since Applicant does not necessarily agree with the same, but to advance the prosecution of the present application, each of claims 43-47 and 49-50 have been amended above to remove the means plus function terminology.

In view of the above amendments and remarks, the Examiner is respectfully requested to

reconsider and withdraw the rejection of claims 1-14, 17-20, 22, 40-47, 49-50 and 56-60 under 35 U.S.C. Section 112, second paragraph, as being indefinite, as being no longer appropriate

Claims Rejected Under 35 U.S.C. Section 101

Claims 1-14, 17-20, 22, 40-47, 49-50 and 56-60 were rejected under 35 U.S.C. Section 101 as lacking patentable utility due to not being supported by a specific, substantial, and credible utility or a well-established utility. The Examiner asserted that the claimed subject matter is not supported by a specific, substantial and credible utility because the disclosed uses are generally applicable to broad classes of this subject matter.

Applicant respectfully traverses. Applicant respectfully submits that 35 U.S.C. Section 101 does not prohibit patents that have broad applicability. Further, Applicant respectfully submits that the mere fact that an invention may have broad applicability does not logically prevent it from having a specific utility. Applicant respectfully submits that Figs. 1-3, and the description thereof provide a specific, real world, example of use of the present invention to identify cells having the highest degree of upregulation, e.g., see paragraph [0088]. Of course, the present invention is not limited to this use, as this is only one specific example.

Further, the independent claims have been amended to revise the preambles, as noted above, and further to recite that the displayed data provided to the user are in a sort order of arrangement resulting from said sorting and thus reordering. Support for these amendments can be found in the original claims and throughout the specification. It is respectfully submitted that the user would know that the results are based upon the sort performed relative to the pseudo-data vector.

In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 1-14, 17-20, 22, 40-47, 49-50 and 56-60 under 35 U.S.C. Section 101 as lacking patentable utility due to not being supported by a specific, substantial, and credible utility or a well-established utility, as being inappropriate.

Claims Rejected Under 35 U.S.C. Section 112, First Paragraph

Claims 1-14, 17-20, 22, 40-47, 49-50 and 56-60 were rejected under 35 U.S.C. Section 112, first paragraph. The Examiner asserted that the claimed invention is not supported by a specific, substantial, and credible utility or a well-established utility for the reasons set forth above, and therefore one of

ordinary skill in the art would not know how to use the claimed invention.

Applicant respectfully traverses. As noted above, it is respectfully submitted that Figs. 1-3, and the description thereof in the present specification provide a specific, real world, example of use of the present invention to identify cells having the highest degree of upregulation, e.g., see paragraph [0088]. Of course, the present invention is not limited to this use, as this is only one specific example.

Accordingly, in view of the above comments, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 1-14, 17-20, 22, 40-47, 49-50 and 56-60 under 35 U.S.C. Section 112, first paragraph, as being inappropriate.

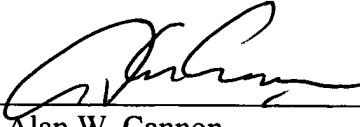
Conclusion

Applicant submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at 408-736-3554.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order number 10031032-1.

Respectfully submitted,

Date: 11/10/08

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